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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Robert J. SMALL

Confirmation No. 4672

Serial No.: 10/803,780

Art Unit: 1762

Filed: March 18, 2004

Examiner: Marianne L. Padgett

For: **RESIDUE REMOVERS FOR  
ELECTROHYDRODYNAMIC  
CLEANING OF  
SEMICONDUCTORS**

Atty Docket No: 60937-0178-US

RESPONSE TO RESTRICTION REQUIREMENT

U.S. Patent and Trademark Office  
Randolph Building  
401 Dulany Street  
Alexandria, Virginia 22314 – MAIL STOP AMENDMENT

Sir:

In response to the outstanding Restriction Requirement issued on July 17, 2007 in the above-referenced application, Applicants hereby provisionally, with traverse, elect to prosecute claims in 1-12 and 17-38, drawn to hydroxylamine or derivatives thereof.

Applicants respectfully submit that the Examiner's decision in each case is improper, at least in part. Under proper restriction practice, every restriction requirement has two criteria: (1) the inventions, as claimed, must be independent or distinct; and (2) there would be a serious burden on the examiner if restriction were not required. MPEP 803.

The Examiner alleges there are five patentably distinct species:

- 1) hydroxylamine and hydroxylamine derivatives – claims 1-12 and 17-38;
- 2) periodic acid – claims 13-16;
- 3) hydrogen peroxide – claims 13-16;
- 4) reducing agent – claims 40-44; and
- 5) organometallics – claims 45-46.

**A. THE CLAIMS ARE NOT DIRECTED TO FIVE DISTINCT SPECIES**

When the claims define the same essential characteristics of a single disclosed embodiment of an invention, restriction is not proper. MPEP 806.03. Inventions as claimed are independent only if there is *no disclosed relationship between the inventions*, that is, they are unconnected in design, operation, and effect. MPEP 806.06. Respectfully, Applicants' find that the Examiner has considered "organometallics" to be a chemical compound when, instead, it is a substrate layer and can be used in conjunction with hydroxylamine and hydroxylamine derivatives.

Under the patent rules, inventions are not unrelated if they can be used together. Clearly, the claims to "organometallics" – namely claims 45-46 – could depend from claim 1 (or claim 13) and, in fact, claims 29-38 do exactly that. Accordingly, the claims to "organometallics" – 45-46, should be considered with claims 1-12 and 17-38.

**B. SMALL DEPENDENT FEATURE VARIATIONS  
DO NOT RISE TO THE LEVEL OF A SERIOUS BURDEN**

The second requirement in determining whether restriction is proper is the determination and showing that not requiring a restriction would result in a serious burden to the Examiner. It is the Examiner's burden to make a *prima facie* showing that it would result in a serious burden. This is not a requirement that can be ignored. In making a restriction requirement, reasons must be detailed sufficiently to establish a *prima facie* showing. A *prima facie* showing includes: (a) separate classification; (b) separate status in the art; (3) a different field of search (as defined in MPEP 806.02); (d) if the prior art applicable to one invention would likely not be applicable to another invention; and (e) the inventions are likely to raise different non-prior art issues. MPEP 803, 806.02. The Examiner's restriction never makes an attempt to satisfy this burden other than to make the conclusory statement that "there would be a serious burden on the Examiner if restriction is not required." This statement is left totally unsupported and is thereby inadequate according to the requirements of the Patent Office rules regarding the Examiner's need to make a

*prima facie* showing. Accordingly, claims 45-46 should not be restricted from claims 1 and those depending therefrom, directly or indirectly.

No fees are believed due with this filing; however, any and all fees deemed necessary may be charged to the Morgan Lewis Deposit Account No. 50-0310.

Date:

September 7, 2007

Respectfully Submitted,



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